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REMARKS

Applicants respectfully submit that the restriction requirement does not conform to the requirements of the governing law. In particular, alleging that a claim represents multiple "patentably distinct" inventions is a *de facto* rejection of the patentability of the claim, because the claim cannot issue as drafted. Therefore, the restriction requirement at issue does not conform to the requirements of 35 U.S.C. § 121 as expressly articulated by the C.C.P.A. Specifically, the C.C.P.A. stated that:

It is apparent that § 121 provides the Commissioner with the authority to promulgate rules designed to *restrict* an *application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It does not, however, provide a basis for an examiner, acting under the authority of the Commissioner to *reject* a particular *claim* on the same basis.

In Re Weber, Soder and Boksay, 198 U.S.P.Q. 328, 331-332 (C.C.P.A. 1978). Further, in the very next case decided by the C.C.P.A., the court interpreted this as a *per se* holding noting that:

In *In re Weber* . . . decided of even date, this court holds that §121 does not provide a basis for rejection of a claim. To the extent that §121 was employed as a basis for rejection, that rejection is, on the authority of *Weber*, reversed.

In Re Haas 198 U.S.P.Q. 334, 336 (*In Re Haas II*) (C.C.P.A. 1978). *See also, In Re Haas* 179 U.S.P.Q. 623 (*In Re Haas I*) (C.C.P.A. 1973). The C.C.P.A. further clarified the rationale behind this rule stating that:

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the rights of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner, rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

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In Re Weber, Soder and Boksay, 198 U.S.P.Q. at 331 (emphasis supplied). Thus, as exemplified by the cases set forth above, the courts have expressly ruled that there is no statutory basis for rejecting a claim for misjoinder, despite previous attempts by the Patent Office to fashion such rejections. In short:

the discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim — no matter how broad, which means no matter how many independently patentable inventions may fall within it.

In Re Weber, Soder and Boksay, 198 U.S.P.Q. at 334.

Instead of improperly imposing a restriction requirement on a claim, the Office may limit initial examination to a "reasonable number" of species encompassed by the claim. See, 37 C.F.R. § 1.146. This practice strikes an appropriate balance between the administrative concerns of the Patent Office relating to unduly burdensome examinations, and the clear constitutional and statutory rights of an inventor to claim an invention as it is contemplated, provided the dictates of 35 U.S.C. § 112 are complied with. Specifically, the C.C.P.A. stated that:

An applicant is given, by the statute, the right to claim his invention with the limitations he regards as necessary to circumscribe that invention, with the proviso that the application comply with the requirements of §112. We have decided in the past that §112, second paragraph, which says in part "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention," allows the inventor to claim the invention as he contemplates it.

In re Wolfrum, 486 F.2d 588, 179 U.S.P.Q. 620 (C.C.P.A. 1973). See, the MPEP at 803.02. See also, *In re Kuehl* 177 U.S.P.Q. 250 (C.C.P.A. 1973). Unlike a restriction requirement, a species election does not preclude an applicant from pursuing the original form of a claim in subsequent prosecution, nor does it force an applicant to file multiple divisional applications, which are incapable of capturing the intended scope of the application. It should be clear that the added costs of filing and prosecuting at least three additional patent applications in view of the present restriction requirement does not strike an appropriate balance between the administrative concerns of the office and the Applicants' statutory and constitutional rights as inventors. This

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would be particularly burdensome for the Applicants mindful that this is the second restriction requirement asserted in this case.

In the instant case, pending claims 1-31 include one independent claim, which provides a method that includes performing a plurality of fermentations, each fermentation in a different sample vessel. The claimed method also includes performing a further processing step on a plurality of fermented samples where the sample is retained in the same sample vessel as the fermentation during the processing steps. As specified above, the Action restricts claims 1-31 into four groups. Three of the specified groups (i.e., Groups II-IV) fail to even include the independent claim. Further, the claims in Group II depend from the claims in Group I, while the claims in Group IV depend from the claims in Group II. Accordingly, if claims 1-31 are required to be divided among separate applications, the claims as drafted would never be considered on the merits. This clearly violates the constitutional and statutory rights of the Applicants to claim their invention as it was contemplated. This restriction requirement would render the Applicants incapable of capturing the scope of the invention. Stated otherwise, the subject restriction requirement is tantamount to rejecting the pending claims, all dependent claims of which ultimately depend from the same independent claim, on the basis that they allegedly represent "independent and distinct" inventions. The Office simply may not restrict dependent claims away from their relevant independent claims. As clearly noted by the courts, dependent claims provide a service to the public by increasing the wealth of technical knowledge disclosed in the patent and providing the public with clarified notice of the extent of the patent rights to be granted, consonant with the dictates of 35 U.S.C. § 112. There is no legitimate basis for restriction between independent and dependent claims, no matter how many statutory classes are involved. *In re Kuehl*, 177 U.S.P.Q. at 256. Indeed, restricting dependent from independent claims is simply a rejection of the form of the claims, because the only way to recapture the restricted claims is to re-write them in an alternate form. Accordingly, the restriction requirement at issue is an explicit example of the procedure absolutely and unequivocally forbidden by the courts. Because this restriction requirement is *per se* improper, Applicants respectfully request that it be withdrawn and that the claimed invention be examined as it was contemplated.

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Applicants further note that the courts have explicitly held that improper restriction of a single claim is a decision under the jurisdiction of the Board of Appeals, and the Federal Courts. This is in contrast to simple administrative decisions regarding ordinary restriction requirements, which are not generally subject to Appellate review. *See, In Re Haas I, supra*. Because restriction of a single claim into multiple groups is tantamount to a rejection and a refusal to examine the claim as drafted, as articulated in *Haas I*, the Board of Appeals and the courts have jurisdiction over the decision. Accordingly, Applicants expressly reserve the right to appeal any decision that may be made regarding the present restriction requirement to the Patent Office Board of Appeals and to the Federal Circuit.

In addition, Applicants traverse the restriction of the claims, because pending claims 1-31 are not independent and distinct. The Action alleges that:

The processes/methods in Groups I-IV are unrelated to each other because they are directed to inventions that are not connected in design, operation and/or effect. These inventions are independent since they are not disclosed as capable of use together.

Action at page 2. Applicants respectfully submit that disclosure of how the claimed operations are related and how they are capable of use together is replete throughout the subject application. As referred to above, the invention relates, *inter alia*, to a method for performing multiple processing steps on a sample in a single vessel. In particular, as related in the "Background of the Invention," pre-existing methods of processing samples for fermentation and, e.g., centrifugation typically include the use of multiple vessels per sample. As discussed throughout the subject application, one of the significant advantages of the claimed invention is performing multiple processing steps, such as centrifugation, sonication, and agitation in addition to fermenting each sample in the same vessel to achieve, e.g., enhanced throughput relative to those prior methodologies. In certain embodiments, the methods further include, e.g., isolating and crystallizing fermentation products or using a robot to test such products among other options. Therefore, the claims of Groups I-IV are related in, e.g., operation and effect, and are explicitly disclosed as capable of use together. Accordingly, the restriction requirement is improper and should be withdrawn.

Applicants further traverse the restriction of the claims as asserted in the Action, because examination of the pending claims does not present an undue burden for examination. A

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restriction requirement, which is within the discretion of the Examiner, is made to avoid placing an undue examination burden on the Examiner and the Office. Where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even if they are directed to independent and distinct inventions. *See*, the MPEP at 803.01. In establishing that an undue burden would exist for co-examination of claims, the Examiner must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. All of the pending dependent claims in the instant case ultimately depend from the same independent claim (i.e., claim 1). Thus, there will necessarily be significant overlap among the prior art searched such that it cannot logically be asserted that co-examination of all pending claims would present an undue burden. This is especially the case mindful of the fact that the single independent claim of the subject application presents a threshold issue for examination.

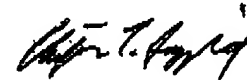
For the reasons set forth above, Applicants respectfully request that the restriction requirement in the present case be withdrawn. There is no statutory authority for imposing a restriction requirement on any particular claim. The courts have expressly held that the type of restriction requirement made by the Examiner is an improper rejection subject to Appellate review. Moreover, the courts have expressly held that an Examiner may not use 35 U.S.C. § 121 as a basis for rejection of a particular claim.

CONCLUSION

Applicants respectfully submit that this response to the restriction requirement is complete and responsive, and that the claims are in a condition for early consideration on the merits. In the event that a telephonic interview would be helpful, please contact the undersigned representative.

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Respectfully submitted,



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